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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,436

08/23/2006

Yoichi Nogata

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EXAMINER

GWARTNEY, ELIZABETH A

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

11/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/590,436	Applicant(s) NOGATA ET AL.	
	Examiner Elizabeth Gwartney	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20060823</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claims 5-6 and 8 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Given claim 2 is directed to a food ingredient that is a 60% flour, since claim 5 and 8 which depend from claim 2 require that the ground product of the seed of wheat or barley is selected from a group of whole meal, bran, shorts, red dog, and 60 % flour, claims 5 and 8 do not further limit the food ingredient of claim 2.

Given claim 3 is directed to a food ingredient comprising a mixture of bran and shorts, since claim 6 which depends from claim 3 requires that the ground product of the seed of wheat or barley selected from a group of whole meal, bran, shorts, red dog, and 60% flour, claim 6 does not further limit the method of making a food ingredient as recited in claim 3.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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With regards to claims 1-2, 4 and 7, the recitation "during maturation period from immediately after the heading until the maturation" renders the claims indefinite because it is not clear what **maturation** encompasses or how it is defined.

With regards to claims 1-3, the recitations "wherein the content of free glutamine is. . .the content of valine is . . ., the content of isoleucine is . . ., the content of leucine is. . . and the content of arginine is . . ." renders the claim indefinite because it is not clear if the recitation refers to the content of each specific amino acids or that the food ingredient comprises a specific amount of each amino acid.

With regards to claims 1-3, the recitation of amino acid content in units of mg/100g renders the claims indefinite. First, it is not clear if the recited amino acid contents are based on a dry or wet weight. Further, it is unclear if the amino acid content is based on 100g of food ingredient, 100 g ground barley or wheat, 100 g protein, etc.

With regards to claims 2, 5-6 and 8, the phrase "60% flour" renders the claims indefinite. It is unclear what is encompassed by 60% flour, given the food ingredient is obtained by grinding the seed of wheat or barley and the particle size of the flour is not defined. In other words, in some cases, ground barley or wheat would be considered 100% flour.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walmsley et al. (US 3,716,365).

Regarding claims 1-8, Walmsley et al. disclose a beer brewing ingredient and the process of making the ingredient comprising heating an aqueous slurry of ground barley at about 40° to about 55°C for a period of between about 30 and about 120 minutes (C8/L66-71). Walmsley et al. disclose that the pH of the water is adjusted to between about 5.2 and 5.8 and remains essentially the same throughout the process (C8/L59-62).

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While Walmsley et al. disclose ground barley ground in a Hobart Model 2020 Grinder adjusted to No. 1 setting, the reference does not explicitly disclose a mixture of brand shorts or a 60% flour.

Given Walmsley et al. disclose ground barley, since bran and shorts are derived from barley, it is clear that the beer brewing ingredient would comprises bran and shorts.

While Walmsley et al. disclose ground barley with a given particle size distribution, the reference does not explicitly disclose 60% flour. As flowability of the ground product in processing is a variable that can be modified among others, by adjusting the particle size distribution of the ground barley, the precise particle size distribution, i.e. percentage of flour, would have been considered a result effective variable by one of ordinary skill in the art at the time of the invention. As such, without showing unexpected results, the claimed flour percentage cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine experimentation, the percentage in the beer brewing ingredient of Walmsley et al. to obtain the desired processing flowability (*In re Boesch*, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (*In re Aller*, 105 USPQ 223).

With regards to amino acid content, given Walmsley et al. disclose an ingredient and process of making the ingredient substantially the same as presently claimed, it is clear that the ingredient would intrinsically displayed the recited amino acid profile.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Gwartney whose telephone number is (571) 270-3874. The examiner can normally be reached on Monday - Friday; 7:30AM - 3:30PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. G./

Examiner, Art Unit 1794

/Keith D. Hendricks/

Supervisory Patent Examiner, Art Unit 1794